

REMARKS

Reconsideration of the present application is respectfully requested.

A telephonic interview was scheduled for January 20, 2004 with Examiner Nguyen and his supervisor, Examiner Friedman. Examiner Nguyen called on the morning of January 20, 2004 and canceled the joint telephonic interview with Examiner Nguyen and Friedman. Examiner Nguyen advised the Applicant's Representative that the claim rejections in the prior Office Action of December 17, 2003 would not stand. Examiner Friedman was not involved in the discussion and no substantive discussion of the claims or the prior art was had with Examiner Nguyen during the January 20, 2004 telephone call. Applicant's Representative had a separate short telephone discussion with Examiner Friedman later on January 20, 2004 to clarify the status of the case. Examiner Friedman agreed that the Applicant's Representative would be afforded an opportunity to have an interview at a later date if needed in this application. Applicant's Representative thanks Examiner Nguyen and Examiner Friedman for the courtesy and professionalism during the respective telephone discussions.

The Applicant's Representative received an Interview Summary dated January 22, 2004 regarding the present Application. The Interview Summary sets forth that "with the examiner's supervisor advise, the last office action will not stand, and will waiting for the applicant's response for further search." Accordingly, Applicant respectfully

traverses the rejections of claims 24-56 under 35 USC §103 set forth in the Office Action dated December 17, 2003.

Claims 24-56 were rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 5,743,056 to Balla-Goddard in view of U.S. Patent No. 5,836,628 to Beier. Applicant respectfully traverses the §103 rejection. In reviewing claims for patentability the Manual of Patent Examination instructs that "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." *See*, MPEP § 2142. "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *See, Id.* The Federal Circuit reiterated in *In re Oetiker*, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992), that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination" and "[t]hat knowledge can not come from the applicant's invention itself." Further, "[a]bsent such suggestion to combine the references, respondents can do no more than piece the invention together using the patented invention as a template. Such hindsight reasoning is impermissible." *Texas Instruments Inc. v. U.S. Int'l Trade Comm'n*, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).

The Office Action provides that Balla-Goddard teaches "a sheet of drywall 52 having a drywall thickness and adjacent the interior facing sheet 56, the drywall having an interior surface, a trim piece 208, a jamb member 26, service ducts 103 located between the plaster board or drywall 52 and the panel 16 for electricity cables, telephone lines, server (sic) pipes and/or gas pipes, a window opening (col. 7, lines 40-43, 65-66." Office Action page 2, December 17, 2003. In reviewing the Office Action the Examiner

is directed to FIG. 4 and the supporting text set forth in the '056 specification between column 7, line 65 and column 8, line 19. More specifically, the item 208 cited by the Office Action as a trim piece is referenced in the '056 reference as an L-shaped bracket 208. The L-shaped brackets are on the outside of the opening and are used to hold a window frame 34. The L-shaped brackets 208 are on the exterior side of the 16 and clearly do not extend flush across a jamb and drywall. The item 206 referenced as a jamb member in the Office action is a window sill that covers the bottom of the opening and extends beyond the interior plane of the plasterboard 52.

The Office Action utilizes the '628 reference to modify the '056 reference to include a jamb member having a thickness equal to the overall thickness of the sum panel thickness. The Applicant does not follow how the completed wall in the '628 reference would have to include a drywall sheet as referenced in the Office Action.

The Office Action summarily dispenses with the declaration of Mr. Patrick Egan. More specifically, the Office Action provides "the applicant's discovered panel thickness ranges had some commercial success over years; however, the examiner considers this would have been an obvious design choice for a desirable application." The Examiner is reminded that the law is well settled that in evaluating obviousness type rejections under 35 USC §103 the Patent Office must always consider evidence of secondary considerations when presented. Cable Elec. Prods., Inc. v. Genmark, Inc., 226 USPQ 881, 887 (Fed. Cir. 1985). The Federal Circuit has directed that:

when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light. Such objective indicia as commercial success, or filling an existing need, illuminate the technological and commercial environment of the inventor,

and aid in understanding the state of the art at the time the invention was made.

Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746, 1752 (Fed. Cir. 1991).

This "evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not." Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871, 879 (Fed. Cir. 1983).

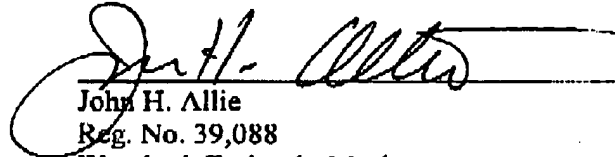
In responding to the previous Office Action there was included a Declaration of Mr. Pat Egan. The Declaration provides data supporting the commercial success story regarding products sold by Mr. Egan's company THERMOCAORE. The Declaration is specific that there are a variety of Pre-Fabricated Panel configurations sold by Mr. Egan's company and that many of the configurations are covered by claims in the pending application. However, there may also be some Pre-Fabricated Panel configurations that are included in the sales volume, but are not covered by a pending claim.

The Declaration of Mr. Patrick Egan provides evidence regarding the commercial success of many products associated with the present application. A pair of prior Declarations filed October 21, 2001 by Dave Scheilder and Ray Micham articulates the sentiment of at least two people of experience in the industry. The Declarations provide evidence of the filling of an unmet existing need, and of the commercial success of the present invention.

The Examiner is respectfully requested to reconsider the present application and issue a timely Notice of Allowability for claims 24-56. If there are any remaining issues

the Applicant's Representative respectfully requests a telephonic interview with the Examiner and his Supervisor.

Respectfully submitted,



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